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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/172,830 10/15/98 ZANCO

A 2348-348/2.R

EXAMINER

QM12/0712

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KAVANAUGH, J	
ART UNIT	PAPER NUMBER

3728

25

AIR MAIL

DATE MAILED:

07/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/172,830

Applicant(s)

ZANCO, ALAIN

Examiner

Ted Kavanaugh

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) 7, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 5-4-01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/172830 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

2. Claims 1-3,5,8,9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 1, the phrase "the boot having a heel and a sole" is unclear. It would appear the sole would be elements 1 and 2 but it is not clear what element the heel is.

In claim 1, the phrase "wherein the boot has a rigid part in a rear region of the boot, over about one half of the length of the sole" is inaccurate, unclear and indefinite. It would appear applicant is referring to element 1 and 5 as the rigid part. However, applicant says it is in the rear region of the boot but yet the claim also states that it is "over about one half of the length of the sole", therefore the rigid part is not just in the rear region of the boot. They contradict each other.

In claim 1, the phrase "wherein the rest of the sole is flexible" is unclear and indefinite. This phrase implies that the a first portion or some portion of the sole has been referred to. However, only the "a sole" has been previously referred to.

Regarding the "interlocking surface" is it still not totally clear what element applicant is refereeing to. An applicant point out it is shown in every embodiment and refers to elements 11,12,13, and 14. However, none of these elements are in the elected species (figs. 1,3 and 4). The examiner has concluded applicant must be referring to the recesses or bearing surface (6,7) in the sole (1) as shown in figure 3. However, language in the remaining claims doesn't refer to these elements as the interlocking surface. The languages throughout the remaining claims refer to these recesses or cutouts as a new item and therefore the claims are indefinite. See claims 5,8 and 9. Claim 5, "at least one cutout". Claim 8, "a profiled part" and Claim 9, "at least part of the binding interfacing portion". The "binding interfacing portion" in claim 9 ,also doesn't lack proper antecedent basis since this language was amended in claim 1.

Claim 2 is indefinite since it is further limiting the ski binding which isn't even being claim.

In claim 9, "the rigid portion" is indefinite since only a "rigid part" has been previously defined.

Throughout the claims applicant refers to the bearing surface (6,7) in several different ways, such as "at least one cutout" and "a profiled part" which leads to confusion. Applicant must use consistent terminology throughout the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1,2,8,9 is/are rejected under 35 U.S.C. 102(e) as being anticipated by 4674202 (*Bourque*).

Keep
8-10
Fig. 1
Bourque teaches a boot having structure substantially as claimed including the sole have a rigid part (the first half of the sole is rigid because of element 10 which is rigid in areas 14 and 16) and the rest of the sole is flexible. The front half of the rigid part (10) has grooves (28) that permit the front half of the sole to be flexible. The sole of Bourque has a profiled part (the cutout as shown in the rear of sole in figure 2). This profiled part is inherently capable as functioning as an interlocking surface as claimed.

5. Claims 1-3 is/are rejected under 35 U.S.C. 102(e) as being anticipated by US 4246708 (*Gladek*).

Gladek teaches a boot having structure substantially as claimed including the sole have a rigid part in the rear region that encloses the heel and the rest of the sole being flexible. The front half of the sole is flexible due to the apertures (10) that permit the front half of the sole to flex. The outer surface of the rigid sole part is inherently capable as functioning as a interlocking surface inasmuch as a binding can is capable of lacking on to this surface.

6. Claims 1-3 is/are rejected under 35 U.S.C. 102(e) as being anticipated by US 5884420 (*Donnadieu*).

Donnadieu teaches a boot having structure substantially as claimed including the sole have a rigid part (3) in the rear region that encloses the heel and the rest of the sole (15) being flexible. All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. The outer surface of the rigid sole part serves as the interlocking surface.

7. Claims 1-3 is/are rejected under 35 U.S.C. 102(e) as being anticipated by US 5899006 (*Donnadieu*).

Donnadieu teaches a boot having structure substantially as claimed including the sole have a rigid part (3,8) in the rear region that encloses the heel and the rest of the sole (2) being flexible. All of the functional claim language and statements of intended

use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. The outer surface of the rigid sole part serves as the interlocking surface.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5,8,9 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over *either [Donnadieu '006 or '420 or Gladek] in view of Bourque '202 and US 4186500 (Salzman)*.

Donnadieu and Gladek all teach a boot (cross-country boots) substantially as claimed except for a cutout/profile part in the rigid sole part of the boot. Bourque and Salzman both teach cross-country boots have a rear cutout portion (or a profile part). It would have been obvious to provide the boot of either Donnadieu or Gladek with a cutout portion, as taught by Bourque and Salzman, to provide reinforcement to the sole of the boot and to facilitate securing to a binding.

10. Claims 3,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourque '202 in view of Donnadieu or Gladek.

Bourque teaches a boot substantially as claimed (see the rejection above for details) except for a rear part rigidly enclosing the heel. Donnadieu and Gladek both teach providing a boot with the sole having an integral rigid heel part. It would have been obvious to one of ordinary skill in the art to provide the boot as taught by Bourque with the sole having a rigid part enclosing the heel, as taught by either Donnadieu or Gladek, to prevent twisting in the rear part of the boot.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-3,5,8 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,173,510. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same essential features such as a boot having rigid and flexible portions and an interface (interlocking surface).

Conclusion

13. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 305-3579 or (703) 305-3580 or (703) 305-3590 (**FORMAL FAXES ONLY**). Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to

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Tech Center 3700 Customer Service at (703) 308-5648, email

CustomerService3700@uspto.gov .

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T Sewell can be reached on (703) 308-2126.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/


Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
July 10, 2001